

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on November 16, 2005, the Examiner allowed claims 1, 3-9 and 12-14. The Examiner rejected claims 10, 11, 15, 17-23, and 25-35 and objected to claim 24. Applicants provide the following in response to the Examiner's rejections and objections.

Claim Rejections Under 35 U.S.C. §112, First Paragraph, and 35 U.S.C. 102(a) in light of Chi

The Examiner rejected claim 32 under 35 U.S.C. §112, first paragraph for failing to comply with the written description requirement. Specifically, the Examiner asserts that the claim contains subject matter not described in the specification in a way as to reasonably convey to one skilled in the relevant art that the inventors were in possession of the claimed invention at the time the application was filed. Additionally, the Examiner rejected claim 32 under 35 U.S.C. §102(a) as anticipated by Chi. Applicants amend claim 32 and respectfully provide the following remarks.

As amended, Claim 32 reads:

32. A storage apparatus comprising:

a bag having a side and a pocket integrated therein, the pocket further comprising:
a front panel; and

a first and second ~~substantially triangular~~ side panel biasing means coupled to said front panel wherein the side panels are made of elastic material capable of ~~to~~ biasing said front panel against said bag, and thereby creating an automatic seal.

Applicants respectfully submit that Claim 32, as amended and for the reasons set forth below, is now in condition for allowance.

First, with regard to the Examiner's rejection under 35 U.S.C. §112, Applicants submit that claim 32 is described in the specification in Figures 2 and 3b, which reasonably conveys to one skilled in the art that Applicants had, at the time the application was filed, possession of the claimed invention. Figures 2 and 3b satisfy a rejection under 35 U.S.C. §112, because as the Federal Circuit holds "an applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997) (emphasis added).

Applying the foregoing rule to the present context, Figures 2 and 3b specifically illustrate how the first and second side panel's biasing means is made of flexible material capable of biasing the front panel against the bag to create an automatic seal, and does so sufficiently to preclude a 35 U.S.C. §112 rejection.

Second, newly amended claim 32 is no longer appropriate for a rejection under 35 U.S.C. §102(a) as anticipated by Chi. Applicants assert that because Chi does not disclose Applicants' limitation of a biasing means that creates an automatic seal of the pocket when the bias force is released. And, because a rejection under 35 U.S.C. §102(a) requires the prior art reference teach each and every element of the claimed invention, claim 32 is now in condition for allowance. See *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

To illustrate, Applicants submit that unlike Chi, Applicants' biasing means creates an automatic seal or complete and impenetrable closure of the pocket when the biasing force is released (i.e., when the front panel is let go.) (see Application, p. 4, ll. 7-9, page 9 ll. 14-16, 20-21). In contrast, Chi's compressive element 14, must be *manually* tightened by a strap or lever. There is no *automatic* seal. (see Chi, paragraphs 16 and 19). Thus, Chi fails to teach each and every element under Section 102.

Claim Rejections Under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 10, 11, 15, 17-23, 29 and 30 as indefinite for failing to particularly point out and distinctly claim the subject matter that applicants regards as the invention. Specifically, Examiner writes "there is insufficient structural relationship between the pouch of claim 8 and a bag for a grip element coupled to the pouch to effect leverage and transport of the bag as claimed in claim 10," and continues, "Insofar as the bag is claimed, it is an isolated element."

As amended, Claim 10 now states:

10. The pocket assembly of claim 8, wherein said accessory pouch further comprises a grip element coupled to said front of said accessory pouch to facilitate leverage and transport of said a bag accessory pouch of said pocket device.

Applicants respectfully submit that amended claim 10 now reflects sufficient structural relationship between the pouch of claim 8 and a bag, and for the grip element coupled to the pouch, to enable leverage and transport of the bag.

In addition, the Examiner says something appears “left out” of claim 15, and that sufficient structural relationship is also left out in claims 25 or 29 for the foregoing reason. Applicants addresses these rejections below.

As amended, claim 15 now reads:

15. A bag comprising:

an outer housing for receiving and retaining a plurality of items;

a pocket formed with said outer housing for receiving and retaining at least one accessory, wherein said pocket comprises:

a front panel;

a bottom support panel;

a back panel, wherein said back panel is recessed into said outer housing;

expandable side panels coupled between said front panel and said back panel such that said side panels fold when the front panel is positioned against the bag and expand ~~in-accordion fashion~~ as said front panel is opened to gain access to the inside of said pocket; and

at least one biasing element longitudinally disposed, ~~along~~ said front panel and coupled to said outer housing that serves to bias said front panel against said outer housing to ~~close~~ automatically seal said pocket.

Applicants submit that claim 15 is similarly in condition for allowance, because of the foregoing clarifications, including the addition of the term “along said front panel,” which illustrates that the biasing element is no longer isolated and unconnected.

As amended, claim 25 now states:

25. A method for facilitating retention of and access to items in a bag, said method comprising:

providing a bag having a pocket member integrated with said bag with an opening for receiving and retaining at least one item;

coupling to a front panel of said pocket member a first portion of at least one elongate biasing member; and

attaching a second portion of said at least one elongate biasing member to said bag, wherein said at least one elongate biasing member is attached to said bag and extends from below a pivot axis up the edge of the front panel and straightens to ~~close~~ automatically seal shut said pocket member.

Applicants submit claim 25 and consequently, its dependent claim 29, are now in condition for allowance, because with the clarification of “integrated with said bag” there is now sufficient structural relationship set forth between the bag and pocket member for a grip element on the pocket member to enable the function claimed of leveraging and transporting the bag.

As amended, claim 30 states:

30. The method of claim 25, further comprising coupling to at least one of said bag and said pocket member a guard member proximate ~~an~~ said opening to said pocket member, wherein said guard member extends beyond said opening of said pocket member to protect an interior of said pocket member when said pocket member is closed.

Finally, Applicants submit that claim 30 as amended, is also in condition for allowance, because it overcomes the Examiner’s rejection based on there being a double inclusion.

Claim Rejections Under 35 U.S.C. §103(a) as Unpatentable over Bieber et al. in View of T. Johnson ‘071

The Examiner rejected claims 25-27, 30, 31 and 34 as unpatentable over Bieber et al. in view of T. Johnson ‘071 for “reasons set forth in the March 8, 2005 office action.” These rejections are respectfully traversed for reasons set forth below.

M.P.E.P. 706.02(j) sets for the standard for a Section 103(a) rejection:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F. 2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)(emphasis added.)

Neither Bieber nor Johnson, nor the combination of the two, teach or suggest all claim limitations because neither discloses a pocket that automatically seals to the extent that complete and impenetrable closure results when the pocket is closed. Put another way, if a person were to lift the attaché case of Bieber and jostle it, or even turn it upside down, the contents within the pocket would fall out. In fact, in order for the contents within the pocket (i.e., file folder) of Bieber to be automatically sealed and completely unexposed, the entire attaché case must be *manually* closed. Moreover, when compressed, some portion of the contents within the file folder remains exposed. Thus, there is no automatic “seal” that provides complete impenetrable closure.

The same is true for Johnson. Similarly to Bieber, to retain and close from exposure the contents of the pockets (i.e., file folders) of Johnson, the entire brief case or bag must be *manually* shut. That is, contents within the pocket must be manually covered in order to prevent them from falling out of the bag if it was turned upside down, or to prevent someone from touching the top of the contents with their fingers.

Thus, as amended, Applicants' respectfully submit that claim 25 teaches the limitation that the pocket automatically seals when closed and that the contents are not exposed once the biasing member is straight.

Applicants' additionally submit that if the pocket taught in Johnson was Applicants' bag, then the pockets would be inoperable because nothing in Johnson or Bieber *automatically* covers or seals the top of the pocket or prevents the contents from falling out when carried or moved upside down.

In sum, Bieber et al.'s *attache* case and Johnson's brief case or bag both teach an additional element, the closure of the entire brief case, and not of a biasing member that when straight, automatically seals shut the pocket.

Inasmuch as claims 26, 27, 30, and 31 are dependent on the newly amended claim 25, Applicants submit they are also in condition for allowance.

The Examiner similarly rejected claim 34 as unpatentable over Bieber et al. in view of T. Johnson '071.

As amended, claim 34 reads:

34. A bag having a pocket formed therein, the pocket comprising:

a pocket;

a flexible rod disposed along the edge of the pocket and extending below a bottom of the pocket to contact a surface of said bag; and a retaining loop disposed above the end of said rod, wherein said flexible rod enables said pocket to automatically seal shut.

Applicants respectfully traverses this rejection and submits that the claim limitations of the "flexible rod that is disposed along the edge of the pocket" as well as "the retaining loop

disposed above the end of said rod” are not taught in Bieber or Johnson. Additionally, in Bieber the wire 45 limitation merely “urges” the file folder snugly against the top wall (Bieber, col. 2, ll. 49-52) rather than automatically seals the pocket closed as taught in Applicants’ claimed invention.

Claim Rejections Under 35 U.S.C. §103(a) as Unpatentable in View of Alter

The Examiner indicated that claim 28 remains rejected under 35 U.S.C. §103(a) as being unpatentable for reasons similar to those used to reject claim 25, and additionally, rejected claim 38 in view of Alter for the reasons set forth in paragraph 7 of the March 8, 2005, Office Action. Specifically, in this office action, the Examiner states, “to have provided a grip tab or handle to open the biased pocket would have been obvious in view of such teach by Alter at 16 and 17.”

For the foregoing reasons, Applicants respectfully traverses such grounds for rejection. Once again, if the pockets were not *manually* sealed, or alternatively, if some further manual operation was not carried out, such as closing the attache’ case or bag, the pocket’s contents might fall out and remain exposed. Thus, newly amended claim 25 and consequently, dependent claim 28 are now in condition for allowance.

Claim Rejections Under 35 U.S.C. §103(a) as Unpatentable Over Horiuchi in view of Bieber

The Examiner rejected claims 25-27, 30 and 31 under 35 U.S.C. §103(a) as being unpatentable over Horiuchi in view of Bieber for the reasons set forth in paragraph 6 of the July 9, 2005, office action. Paragraph 6 states, “to have formed the file pocket of Horiuchi in the manner taught by Bieber so that it remains closed would have been most obvious,” and “that whether the biasing member lies at the edge of the panel or inward is merely considered to be a

matter of degree difference, which is not considered to alter the housing as opposed to the inner housing of Horiuchi at 18.”

Niether Bieber nor Horiuchi, nor their combination, teach or suggest all claim limitations because as found in Applicants’ invention, there is no biasing member that straightens to create the automatic seal of the pocket. Again, the automatic seal that results from the biasing member becoming straight, prevents contents within the pocket from becoming exposed or falling out if the pocket of Horiuchi or Bieber were jostled and turned upside down. Thus, closing Horiuchi’s pocket in the manner taught by Bieber still does not satisfy all elements of the claimed invention.

Claim Rejections 33 and 35 Under 35 U.S.C. §103(a) as Unpatentable over Appel ‘624 in View of Chi

The Examiner rejected claims 33 and 35 under 35 U.S.C. §103(a) as unpatentable over Appel ‘624 in view of Chi. Specifically, the Examiner analogizes Appel’s member 26 to the “biasing means” found in Applicants’ invention. However, Applicants’ claim 33 states the limitation that the biasing means pivotally “closes” said pocket. In contrast the “biasing means” of Appel “opens” the pocket and does not do so with respect to a pivotal axis. (Appel, ll. 87-94) In fact, Figures 1 and 2 of Appel, and lines 87-94 show and describe that, but for the closure tab 30, the pocket would open. This is not the case in Applicants’ claim 33. While the biasing means of Appel provides pressure for the pocket to *open*, and does not do so with respect to a pivotal axis, the limitation found in claim 33 describes a biasing means that *pivotally closes* the pocket.

Moreover, claim 33 was amended to reflect, unlike Appel or Chi, the pocket is automatically sealed, without requiring a closure tab to prevent contents from falling out when jostled or when the bag is turned upside down, or to prevent the contents from being minimally exposed.

Claim Rejections Under 35 U.S.C. §102(b) as Anticipated by Bieber

The Examiner rejected claim 33 under 35 U.S.C. §102(b) as anticipated by Bieber et al '340 of record.

An invention is unpatentable under Section 102 if “the invention was...” A Section 102 rejection is only appropriate, however, where the “reference fully discloses in every detail the subject matter of a claim.” *Application of Foster*, 383 U.S. 966 (1966). For the reasons set forth below, Applicants submit the reference cited by the Examiner does not teach each and every element of the claimed invention, and thus, does not bar the claimed invention as a public use of the invention more than one year prior to the date of application.

As amended, claim 33 now reads:

33. A retaining system comprising:

a bag having a clam-like pocket integrated therein wherein a biasing means pivotally closes said pocket along an axis of rotation disposed along a bottom of said pocket wherein said pocket is automatically sealed upon closure.

Again, as argued previously, Bieber does not disclose every element in Applicants' invention. Bieber does not disclose of a pocket that is impenetrably and automatically sealed when closed. In Bieber, unless manually covered, the contents are still exposed at the top of the pocket.

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Moreover, when in a “closed condition” one may still force his or her fingers into the pocket to touch the contents.

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CONCLUSION

If any impediments to the allowance of this application for patent remain after the above amendments and remarks are entered, the Examiner is invited to initiate a telephone conference with the undersigned attorney of record.

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Respectfully submitted,



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